

## **REMARKS**

Claims 1-15 are present in the above-captioned application and have been subjected to restriction under 35 U.S.C. § 121 (37 C.F.R. § 1.142). Specifically, the Official Action avers the following inventions are present in the claims:

Group I, Claims 8-15, drawn to a process of making a semiconductor device, classified in class 438, subclass 620.

Group II, Claims 1-7, drawn to a semiconductor device, classified in class 257, subclass 620.

In support of the present restriction requirement, the Examiner alleged that the subject matter defined by the claims of the present invention represents two distinct inventions stating that:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, instead of using a wet etch, perform selective deposition of metal interconnect and barrier layers so as to form a crack stop.

Accordingly, it is in the Examiner's position that each group of claims set forth requires individual consideration as to patentability.

As indicated, and in order to be fully responsive to the Examiner's requirement for restriction, Applicants provisionally elect to prosecute the subject matter of Group II, Claims

1-7, and reserve the right to file one or more divisional applications directed to the non-elected subject matter in this application.

However, pursuant to 37 C.F.R. § 1.111, Applicants hereby traverse the restriction requirement and request reconsideration thereof in view of the following remarks.

The Courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved. In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCA 1973) (emphasis added).

This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal

challenges alleging double patenting. The third sentence of 35 U.S.C. § 121, which states that a patent issuing on a parent application “shall not be used as a reference” against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that § 121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that § 121 does not insulate a patentee from an allegation of “obviousness-type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

These considerations indicate that the imposition of a restriction requirement can lead to situations in which an applicant’s legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee’s rights and to serve the public’s interest in the legitimacy of issued patents, applicants respectfully urge the Examiner not to require restriction in cases such as the present application wherein various aspects of a unitary invention are claimed.

The particular reason given by the Examiner to justify restriction between Groups I, and II, are based on MPEP § 806.05(f). It is respectfully submitted that such a reason is insufficient to support this restriction requirement. In fact, reference to the Manual of Patent

Examining Procedure does not establish compliance with the narrow statutory authorization for restriction requirements. The Manual simply states the policy of the Patent and Trademark Office without force of law; it is not authority for expanding or altering a statutory grant of authority.

The PTO can prescribe requirements in the MPEP, providing those requirements are not inconsistent with the statute, the rules or the case law of the PTO's reviewing court. In re Ressola, 22 U.S.P.Q. 2d 1828, 1832 (Comm'r. PTO, 1992).

Reliance on the supposed classification of the groups of claims does not establish independence and distinctness. The classification system has no statutory recognition as evidence of whether inventions are independent and distinct. The classification system is instead an aid in finding and searching for patents.

The classification system is not a good basis for requiring restriction between claims to the various aspects of applicants' unitary invention, because the system exhibits considerable overlap in technical definitions.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed, classifications seem largely to change in response to considerations of administrative convenience, and often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patents assigned to

different classifications is "independent and distinct" as those terms are used in 35 U.S.C. § 121, which fact proves that basing restriction requirements on the classification system is improper.

For the reasons stated hereinabove, it is again respectfully urged that the Examiner withdraw the requirement for restriction and provide an action on the merits with respect to all the claims. However, if the restriction requirement is maintained, applicants provisionally elect Group II, i.e., Claims 1-7.

Respectfully submitted,

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